

Appln. No. 09/825,910
Amdt. dated Mar.24, 2004
Reply to Office communication of Sep. 24, 2002
Docket 14XZ00098

Remarks/Arguments

This amendment includes a Petition to Revive Under 37 CFR 1.137(b).

Status of the Drawing:

In response to the drawing requirement, Figs. 4 and 5 have been amended to show the legends for the block symbols.

Status of the Detailed Description:

In the Detailed Description, paragraph [0072] has been amended to recite reference numeral 50. Reference numeral 50 is shown in Fig. 5.

Status of the Priority Claim:

The Examiner is requested to acknowledge the receipt of a certified copy of FR Patent Application 00 05311 in support of the priority claim under 35 USC 119(a)-(d). The certified copy was filed with the original filing of this application.

Status of the Claims:

Claims 1 to 10 and 17 to 21 are pending in the application. Claims 1, 6 and 7 are allowed; claims 2 to 5, 8 to 10 and 17 to 21 are rejected under 35 USC 112, second paragraph. It is noted that claim 21 is not specifically identified as rejected under 35 USC 112, second paragraph; however, in view of the Examiner's Advisory Action dated 09/05/02 it is presumed that claim 21 is rejected under 35 USC 112, second paragraph. No claim is rejected under 35 USC 101 or 35 USC 102 or 35 USC 103 or any other paragraph of 35 USC 112.

Rejection Under 35 USC 112, second paragraph:

Claims 2 to 5, 8 to 10 and 17 to 21 are rejected under 35 USC 112, second paragraph, as being indefinite for stated reasons. The applicant respectively traverses this rejection and every reason stated by the Examiner. In furtherance of overcoming the indefiniteness, claims 5, 7, 8, 9, 10, 17, 19 and 21 have been amended to ensure antecedent basis for the recited subject matter.

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The Remarks/Arguments previously submitted in this application with regard to any rejection under 35 USC 112, second paragraph, are incorporated by reference.

The rejection is made under 35 USC 112, second paragraph. No rejection is made under any other paragraph of 35 USC 112, and in particular, the failure to satisfy the sixth paragraph for claims 2, 3, 4, 8, 9, 10, 17, 18, 19, 20 and 21.

It would be instructive for further consideration of this application to note a controlling judicial analysis of 35 USC 112, second paragraph. Set out below is the standard recited by the Court of Appeals for the Federal Circuit in Bancorp Services, L.L.C. v. Hartford Life Insurance Company et al., No. 03-1181, decided March 1, 2004. The observations made with regard to the role of the court are equally applicable to the role of the Examiner when considering a claim under 35 USC 112, second paragraph.

"Section 112, paragraph 2, of the Patent Act, 35 U.S.C. § 112, ¶2, requires that the claims of a patent 'particularly [point] out and distinctly [claim] the subject matter which the applicant regards as his invention.' A determination that a patent claim is invalid for failure to meet the definiteness requirement of 35 U.S.C. § 112, ¶2 is a conclusion 'that is drawn from the court's performance of its duty as the construer of patent claims [and] therefore, like claim construction, is a question of law...'. Atmel Corp. Info. Storage Devices, Inc., 198 F.3d 1374, 1378 (Fed. Cir. 1999); accord S3 Inc. v. nVIDIA Corp., 259 F.3d 1364, 1367 (Fed. Cir. 2001). In ruling on a claim of patent indefiniteness, a court must determine whether those skilled in the art would understand what is claimed *when the claim is read in the light of the specification* (emphasis added). Personalized Media Communications, Inc. v. Int'l Trade Comm'n, 161 F.3d 696, 705 (Fed. Cir. 1998); Orthokinetics, Inc. v. Safety Travel Chairs, Inc., 806 F.2d 1565, 1576 (Fed. Cir. 1986).

We have held that a claim is not indefinite merely because it poses a difficult issue of claim construction; if the claim is subject to construction, i.e., it is not insolubly ambiguous, it is not invalid for indefiniteness. Honeywell Int'l, Inc. v. Int'l Trade Comm'n, 341 F.3d 1332, 1338-39 (Fed. Cir. 2003). That is, if the meaning of the claim is discernible, 'even though the task may be formidable and the conclusion may be one over which reasonable persons will disagree, we have held the claim sufficiently clear to avoid invalidity on indefiniteness grounds.'

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Exxon Research & Eng'g Co. v. United States, 265 F.3d 1371, 1375 (Fed. Cir. 2001). By finding claims indefinite only if reasonable efforts at claim construction prove futile, we accord respect to the statutory presumption of patent validity, see 35 USC § 282, and 'we protect the inventive contribution of the patentees, even when the drafting of their patents has been less than ideal.' Exxon, 265 F.3d at 1375. Thus, 'close questions of indefiniteness in litigation involving issued patents are properly resolved in favor of the patentee.' Id. at 1380....

It is further instructive to consider a judicial analysis for a claim presented in accordance with 35 U.S.C §112, ¶6. If a claim is written in the statutory acceptable (35 USC §112, ¶6 means-plus-function form, the requirement that the claim must particularly and distinctly define the invention is met if a person experienced in the field of the invention would understand the scope of the subject matter, reading the claim in conjunction with the rest of the specification. S3 Inc v. nVIDA CORP., 59 USPQ2d 145, 1747 (Fed. Cir. 2001). "If the claims when read in the light of the specification reasonably apprise those skilled in the art of the scope of the invention, § 112 demands no more." Id. "In claims subject to §112, ¶6, the claimed function and the supporting structure [or steps] in the specification must be described with sufficient particularity to meet the requirements of §112, ¶2, Id., and §112, ¶1. Budde v. Harley-Davidson, Inc., 58 USPQ2d 1801, 18206 (Fed. Cir. 2001). "[T]he corresponding structure(s) [or steps] of a means-plus-function limitation must be disclosed in the written description in such a manner that one skilled in the art will know and understand what corresponds to the means limitation. See S3 Inc v. nVIDA CORP., supra, at 1747. A claim cannot be regarded as indefinite simply because it is difficult to understand when viewed without the benefit of the rest of the specification, Id. at 1748.

An indefiniteness challenge to a means-plus-function claim requires the challenger to show, by clear and convincing evidence, that a person skilled in the art would not find, in the specification, a structure [or step] adequate to perform the recited function. See Budde, supra, 58 USPQ2d at 1806.

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Applying the above criteria and the manner for conducting examination of claims under 35 U.S.C §112, ¶ 2 and 6 and the applicable instructions found in the MPEP, it is clear that the claims as presented are not indefinite. The Examiner is not permitted under either 35 U.S.C §112, ¶ 2 or 6 to speculate as to the scope and extant of any term or phrase recited in the claim nor is permitted to hypothesize with alternative or substitute terms or phrases. **The Examiner has failed to demonstrate how or why the terms and phrases recited in the claims do not have meaningful antecedent basis and support in the detailed description as filed or to one skilled in the art.** The Examiner is not obligated to determine “metes and bounds” of a pending claim – that is determination is made incident to asserting the claim. The obligation of the Examiner is to search the state of the art to determine whether the subject matter as claimed is entitled to a patent and to determine whether the application, including the parts thereof, are in compliance with applicable sections of Title 35.

In regard to the rejected claims 2-5, 8-10 and 17-21 and by way of example only:

“means for recognition” is found at least at paragraphs [0032] and [0038];

“detection element” or “element” is found at least at paragraphs [0032], [0039], [0033], [0057] [0062], [0063] and [0065];

“adapter” is found at least at paragraphs [0033] and [0064];

“element having a given x-ray absorption removably fixed on the device” is found at least at paragraphs [0010], [0038], [0058], [0060], [0061], [0066] and [0067];

“means for coding” or “coder” is found at least at paragraphs [0037], [0038], [0039], [0061] and [0068];

“image chain” is found at least at paragraphs [0042], [0047] and [0048];

“parameters of the object” is found at least at paragraphs [0043], [0072] and [0073];

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"parameters of acquisition" is found at least at paragraphs [0047], [0048], [0052] and [0071];

"parameters of the means for receiving" is found at least at paragraph [0070];

"parameters for the positioning of the device" is found at least at paragraph [0069];

"set of rules" is found at least at paragraphs [0082]-[0087];

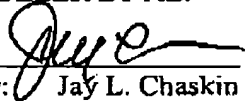
"possibly from one or more parameters chosen by a user" is found at least at paragraph [0091]; and

"support" is found at least at paragraph [0020].

In view of the above amendment to the claims and Remarks/Arguments the applicant requests reconsideration of the application, a Notice of Allowance for claims 1, 6 and 7 and a Notice of Allowance with respect to claims 2-5, 8-10 and 17 to 21 as amended.

Respectfully submitted,

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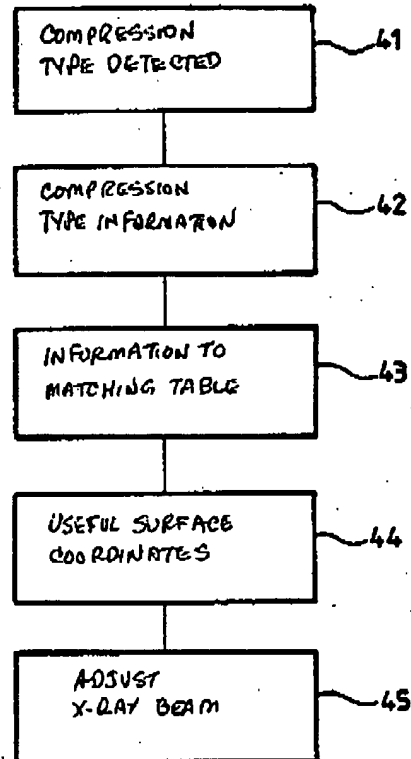
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Annotated Sheet 4/8 Showing Changes

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FIG. 4

LEGENDS ADDED
TO BLOCK SYMBOLS



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Annotated Sheet 5/8 Showing Changes

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FIG. 5

